

### III. REMARKS

Claims 22-28, 30-42 and 56-63 are pending in this application. By this amendment, claims 22, 30, 56 and 60 have been amended. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

Entry of this Amendment is proper under 37 C.F.R. §1.116(b) because the Amendment: (a) places the application in condition for allowance as discussed below; (b) does not raise any new issues requiring further search and/or consideration; and (c) places the application in better form for appeal. Accordingly, Applicants respectfully request entry of this Amendment.

In the Office Action, claims 22-24, 26, 30-36, 40 and 60-63 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Yamaki *et al.* (U.S. Patent No. 5,858,012), hereafter “Yamaki.” Claims 30, 37, 39 and 40 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Hisada (U.S. Patent No. 6,482,196), hereafter “Hisada.” Claims 25 and 27 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Yamaki. Claims 28, 41 and 42 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Yamaki. Claims 38, 41 and 42 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hisada. Claims 56-59 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hisada in view of Glaug *et al.* (U.S. Patent No. 5,601,545), hereafter “Glaug.”

**A. REJECTION OF CLAIMS 22-24, 26, 30-36, 40 and 60-63 UNDER 35 U.S.C. §102(e)**

With regard to the 35 U.S.C. §102(b) rejection over Yamaki, Applicants assert that Yamaki does not teach each and every feature of the claimed invention. For example, with respect to independent claims 22 (and similarly claimed in claim 60), Applicants submit that Yamaki fails to teach or suggest a back guard extending vertically from the rear portion, further wherein the back guard fully extends above the article waistline when the article is worn by the user, *wherein the back guard comprises an absorbent material and a separately positioned elastic.* (emphasis added). To the contrary, the back guard of Yamaki is completely devoid of any elastic (separately positioned or otherwise). The Office equates the separately positioned elastic of the claimed invention with the elastic members 21, 23 of Yamaki. Office Action, page 5, item 4. However, the elastic members 21, 23 of Yamaki are clearly located within the rear portion of the diaper and not in the back guard. See e.g., FIG. 1. To this extent, the elastic members of Yamaki are not located on a portion of Yamaki that extends above the article waistline wherein the article waistline being a substantially same level vertically when worn by the user. Nowhere does Yamaki teach that its elastic members are located on a portion of the garment that is in this extended portion (i.e., back guard).

In contrast, the claimed invention includes "...a back guard extending vertically from the rear portion, further wherein the back guard fully extends above the article waistline when the article is worn by the user, wherein the back guard comprises an absorbent material and a separately positioned elastic." Claim 22, as amended (similarly claimed in claim 60). In fact, both the figures (i.e., figures 1, 2 and 5) and the specification in Yamaki explicitly disclose that the elastic members 21 and 23 are not part and parcel of the extended back guard but are part of

the rear portion of the diaper. For example, the following specification language makes clear that the elastic cannot be part of the back guard: “As shown, an upper end 27 of the rear waist region 7 sufficiently extends upward **beyond the elastic members 21** to overlie an upper end 26 of the front waist region 6.” (emphasis added)(Col. 2, lines 46-49). This is a clear teaching that the elastic members 21 are not in the upper back guard, unlike in the present invention. Thus, the back guard having separately positioned elastic of the claimed invention is not taught or suggested by elastic members 21, 23 of Yamaki. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

With respect to independent claim 30, Applicants respectfully submits that Yamaki also fails to teach or suggest that the back guard extends vertically from the rear portion, further wherein the back guard fully extends above the article waistline when the article is worn by the user, wherein the back guard, has a T-shaped outline. The Office improperly equates the rear end of Yamaki with the back guard of the claimed invention. Col. 2, lines 61-64; FIG. 2. However, Yamaki never teaches that its rear end is a portion that extends vertically above the substantially same level wherein the front portion and rear portion extend to (i.e., article waistline), nor that its rear end has horizontal extensions that extend laterally outward from outer edges of the vertical extension (i.e., has a T-shaped outline). The claimed invention, in contrast, includes “...wherein the back guard [ ] having a T-shaped outline.” Claim 30, as amended. To this extent, unlike in Yamaki, the portion of the incontinence article that extends vertically above the waist area and article waistline (i.e., above the front portion and the rear portion) when worn by a user has opposing horizontal extensions that extend laterally outward from outer edges of the vertical extension (e.g., has a T-shaped outline). For the above reasons, the rear end of Yamaki does not

teach the shape and configuration of the back guard of the claimed invention. Accordingly, Applicants request that the rejection be withdrawn.

With regard to the Office's other arguments regarding dependent claims, Applicants herein incorporate the arguments presented above with respect to independent claims listed above. In addition, Applicants submit that all dependant claims are allowable based on their own distinct features. However, for brevity, Applicants will forego addressing each of these rejections individually, but reserve the right to do so should it become necessary. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

#### **B. REJECTION OF CLAIMS 30, 37, 39 AND 40 UNDER 35 U.S.C. §102(e)**

With regard to the 35 U.S.C. §102(e) rejection over Hisada, Applicants assert that Hisada does not teach each and every feature of the claimed invention. For example, with respect to independent claim 30, Applicants respectfully submits that Hisada fails to teach or suggest that the back guard extends vertically from the rear portion, further wherein the back guard fully extends above the article waistline when the article is worn by the user, wherein the back guard, has a T-shaped outline. The Office cites element 3 and FIGS. 1-2C of Hisada as teaching this feature, stating that "...a portion of the center back guard constitutes a vertical extension and the sides of the back guard constitutes opposing horizontal extensions. Office Action, page 7. However, Hisada does not teach that the sides of the portion of the center back guard extend laterally outward from outer edges of the vertical extension. The claimed invention, in contrast, includes "...wherein the back guard, having a T-shaped outline." Claim 30, as amended. The cited element (i.e., reference 3) of Hisada is rectangular in outline. See e.g., figure 1. Further,

the seamed edges of the upper portion of the Hisada article are not functionally part of any back guard. See e.g., figure 2. To this extent, unlike in Hisada, the portion of the incontinence article that extends above the article waistline (i.e., above the line being substantially same level vertically of the front portion and the rear portion) when worn by a user has opposing horizontal extensions that extend laterally outward from outer edges of the vertical extension. For the above reasons, sides of the portion of the center back guard of Hisada does not teach the horizontal extensions of the claimed invention. Accordingly, Applicants request that the rejection be withdrawn.

With regard to the Office's other arguments regarding dependent claims, Applicants herein incorporate the arguments presented above with respect to independent claims listed above. In addition, Applicants submit that all dependant claims are allowable based on their own distinct features. However, for brevity, Applicants will forego addressing each of these rejections individually, but reserve the right to do so should it become necessary. Accordingly, Applicants respectfully requests that the Office withdraw its rejection.

#### **C. REJECTION OF CLAIMS 25, 27, 28, 38, 41, 42, and 56-59 UNDER 35 U.S.C. §103(a)**

With regard to independent claim 56, Applicants assert that the combined references cited by the Office fail to teach or suggest each and every feature of the claimed invention as is required. For example, Hisada does not teach or suggest having a back guard having elastic positioned *only about a periphery thereof*, as in claim 56 (amended). (emphasis added). To the contrary, as figures 1 through 2C in Hisada clearly show, the article has elastic located throughout the field (i.e., non-periphery portions) of the back guard as shown in elastic members

11A, 11B, 111A, 111B, 211A, 211B and 311A. This is distinguished in the present invention as shown in figure 10. For the above reasons, Hisada does not teach or suggest a back guard having elastic only about its periphery as in the claimed invention. Further, Glaug does not remedy this deficiency in Hisada. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Furthermore, with regard to the 35 U.S.C. §103(a) rejection of claims 25, 27, 28, 38, 41, 42, and 57-59 as being unpatentable, Applicants submit that the cited references do not remedy the glaring deficiencies discussed above in the independent claims (i.e., claims 22, 30 and 56). Accordingly, Applicants respectfully request that the rejection be withdrawn.

With regard to the Office's other arguments regarding dependent claims, Applicants herein incorporate the arguments presented above with respect to independent claims listed above. In addition, Applicants submit that all dependant claims are allowable based on their own distinct features. However, for brevity, Applicants will forego addressing each of these rejections individually, but reserve the right to do so should it become necessary. Accordingly, Applicants respectfully requests that the Office withdraw its rejection.

### III. CONCLUSION

In addition to the above arguments, Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,



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